

REMARKS

Claims 1, 22, 27, 36, 55, 61, and 67 have been amended. Applicants reserve the right to pursue the original claims in this and other applications. Reconsideration and withdrawal of all outstanding rejections are respectfully requested in light of the foregoing amendments and the following remarks.

Claims 61-67 stand rejected under 35 U.S.C. § 112, first paragraph, because the Office Action alleges that the specification does not disclose a controller in the portable memory module for storing data in response to a data retrieval request from a general purpose computer. Claim 61 has been amended to obviate the Office Action's concerns. Claim 61, as amended, recites, *inter alia*, "a controller...for storing in said memory device data received from a general purpose computer in response to a command and for retrieving stored data from said memory device for transmission to a general purpose computer in response to a command from a general purpose computer." As support, Applicant cites to paragraph [0027] of the specification, which discloses "a processor system 500, such as, for example, a desktop or laptop computer." Further, paragraph [0026] of the specification discloses a "processor system 500 with which the portable memory module 100 may wirelessly communicate to exchange data and commands." Therefore, Applicant respectfully submits that the specification supports claim 61 as amended and requests withdrawal of the rejection.

Claim 27 stands rejected under 35 U.S.C. § 112, second paragraph, for reciting the phrase "said second processor system." Claim 27 has been amended to obviate this rejection and withdrawal of the rejection is respectfully requested.

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, for reciting the phrase “said wireless receipt.” Claim 1 has been amended to obviate this rejection and withdrawal of the rejection is respectfully requested.

Claims 1, 3-6, 9-13, and 54 stand rejected under either 35 USC 102(e) as being anticipated by U.S. Patent Pub. No. 2001/0049262 to Lehtonen (“Lehtonen”). This rejection is respectfully traversed.

Independent claim 1, as amended, recites, *inter alia*, “a controller...for storing data in said memory device...and for retrieving stored data from said memory device...in such a way that the memory module functions like an extra hard drive on said processor system.”

Lehtonen does not disclose “a controller” that functions “in such a way that the memory module functions like an extra hard drive.” To the contrary, Lehtonen discloses a mobile phone and headset combination that permits hands-free functioning between the two apparatuses. The Office Action states that Lehtonen discloses a processor MCU and equates the processor MCU to a controller as recited in Claim 1. However, Lehtonen discloses that “[t]he processor MPU uses the software to control the operation of the mobile telephone 22, such as the use of the radio part RF and the Bluetooth transceiver BT, the display of information at the user interface UI and the reading of inputs received from the user interface UI.” Therefore, Lehtonen does not disclose that the processor MCU functions “in such a way that the memory module functions like an extra hard drive.”

Since Lehtonen does not disclose all the limitations of claim 1, claim 1 is not anticipated by Lehtonen. Claims 2-6, 9, 12, 13, and 54 depend from claim 1 and are

patentable at least for the reasons mentioned above. Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection of claims 1, 3-6, 9-13, and 54 be withdrawn.

Claims 61-66 stand rejected under either 35 USC 102(e) as being anticipated by U.S. Patent No. 6,622,031 to McCleary (“McCleary”). This rejection is respectfully traversed.

Independent claim 61, as amended, recites, *inter alia*, “a controller...for storing in said memory device data received from a general purpose computer...and for retrieving stored data from said memory device...in such a way that the memory module functions like an extra hard drive on said general purpose computer.”

McCleary does not disclose “a controller” that functions “in such a way that the memory module functions like an extra hard drive.” To the contrary, McCleary discloses an antenna configuration for a portable wireless transceiver device (column 1, lines 7-10). The Office Action states that McCleary discloses a central processor 101 and equates the central processor to a controller recited in claim 61. However, McCleary discloses that the “central processor 101 coupled with the bus for processing information and instructions” is part of a “computer system 100” (column 5, lines 51-55). Therefore, the central processor 101 disclosed by McCleary does not function “in such a way that the memory module functions like an extra hard drive,” but instead functions in such a way that the portable wireless transceiver device functions as an independent computer.

Since McCleary does not disclose all the limitations of claim 61, claim 61 is not anticipated by McCleary. Claims 62-66 depend from claim 61 and are patentable at least for the reasons mentioned above. Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection of claims 61-66 be withdrawn.

Claims 55-60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,249,690 to Mashiko ("Mashiko") in view of Lehtonen. This rejection is respectfully traversed.

The Office Action fails to establish a *prima facie* case of obviousness at least because Lehtonen in view of Mashiko, even if properly combinable, do not teach or suggest all the claim limitations of independent claim 55. To establish a *prima facie* case of obviousness...the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claim 55, as amended, recites, *inter alia*, "a controller...for receiving data and storing said received data in said memory device and for retrieving stored data from said memory device for transmitting said stored data from said memory module in such a way that the memory module functions like an extra hard drive on said processor system."

Mashiko does not disclose "a controller" that functions "in such a way that the memory module functions like an extra hard drive." To the contrary, Mashiko discloses a portable telephone and a battery charger for the portable telephone. The Office Action states that Mashiko discloses a micro controller 2 (column 13, lines 1-2) and equates the micro controller to a controller recited in claim 55. However, Mashiko discloses that "[t]he receive group 33, the transmit group 37, and the voice processing portion 34 are controlled by a circuit control signal SC from the micro controller 2" and that "[t]he micro controller 2, operating on the basis of a clock generated by a crystal oscillator 41, controls a display of a liquid-crystal display portion 42, receives an input from a keyboard 43, or performs the reading and writing from/to a storage portion 3 as well as outputting the circuit control signal SC" (column 7, lines 24-31). Therefore,

Mashiko does not disclose that the micro processor functions "in such a way that the memory module functions like an extra hard drive." but instead functions in such a way that the portable telephone taught by Mashiko functions as a portable telephone. Furthermore, Lehtonen does not cure the deficiencies of Mashiko because Lehtonen does not disclose "a controller" that functions "in such a way that the memory module functions like an extra hard drive," as discussed above with respect to independent claim 1.

Since Mashiko and Lehtonen do not teach or suggest all of the limitations of independent claim 55, claim 55 is not obvious over the cited references. Claims 56-60 depend from claim 55 and are patentable at least for the reasons mentioned above. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 55-60 be withdrawn.

Claims 22, 24-36, 38-43, and 67-71 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lehtonen in view of Mashiko. The rejection is traversed and reconsideration requested.

The Office Action fails to establish a *prima facie* case of obviousness at least because the Office Action has not provided proper motivation to combine Lehtonen with Mashiko. To establish a *prima facie* case of obviousness...there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regard to claims 22, 24-28, 35, 36, 38-43, and 67-71, the Office Action states that it would have been obvious to modify the system of Lehtonen to include transmission by said transmitter/receiving circuit from said module to any of a plurality of other processing systems as taught by Mashiko since the portable memory module can transfer data to a plurality of other processing systems (page 8). Applicant respectfully disagrees.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Office Action has merely stated that the prior art could be modified, but has not shown the desirability of the modification. In fact, broadcasting a telephone call from a mobile phone to multiple headsets as suggested by the Office Action would be disadvantageous because it would defeat the expectation of privacy normally associated with the use of a telephone.

Furthermore, the Office Action fails to establish a *prima facie* case of obviousness at least because Lehtonen in view of Mashiko, even if properly combinable, do not teach or suggest all the claim limitations of independent claims 22, 36, and 67.

Independent claims 22, 36, and 67, as amended, relate to an apparatus and method involving the wireless transmission of data, that is received by a portable memory module from "a first processing system," from said portable memory module to "any of a plurality of [other] processor systems." The claims as amended make it clear that at least some of the same data that is received by a portable memory module from "a first processing system" is transmitted to "any of a plurality of [other] processor systems."

The Office Action acknowledges that Lehtonen does not teach this limitation (Office Action, page 12). Moreover, Mashiko does not cure this deficiency. In fact, in the passage of Mashiko cited by the Examiner, Mashiko teaches the transmission of a first data between a first processing system and a first battery charger and a transmission of a second, different data between a second processing system and the battery charger. See, Figs. 3-5 and accompanying text, including col. 13, lines 12-42 and col. 10, lines 15-42. Mashiko provides no teaching of wireless transmission of data between a first processor system and a portable memory module and wireless transmission of the same data to a second processor system. Therefore, neither of the cited references, whether considered alone or in combination, teaches or suggests this limitation.

Since Lehtonen and Mashiko do not teach or suggest all of the limitations of independent claims 22, 36, and 67, these claims are not obvious over the cited references. Claims 24-35 depend from claim 22, claims 38-43 depend from claim 36, and claims 68-71 depend from claim 67 and are patentable at least for the reasons mentioned above.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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